UNITED STATES PATENT AND TRADEMARK OFFICE

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Robert D Kucler Esq
Reed Smith LLP
P O Box 488
Pittsburgh, PA 15230-0488

EXAMINER
SINGH, RACHNA

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _26 August 2004_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-20_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-20_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Amendment filed 8/25/04.

2.   Claims 1-20 are pending. Claims 1, 7, 13, and 18 are independent claims.

Claim 5 was cancelled by the amendment

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1-2, 4, 6, 13, and 17 are rejected under 35 U.S.C. 102(e) as being

anticipated by <u>Kolling et al.</u>, US 6,385,595 B1, 5/7/02 (filed 6/25/99).

In reference to claim 1, Kolling teaches an electronic statement presentment

system in which statements are built using a template authoring workstation and

transmitted over a server to a customer. See abstract and column 10, lines 25-38.

Compare to *"a design system, comprised of: a web server"*. The authoring (or

design) system comprises a computer located at the biller (client) who utilizes current

authoring packages to create templates for creating an electronic statement (product).

See column 9, lines 50-67. When a template is sent to the statement origination

workstation, it validates statement data with template. The validation includes

transmitting statement data in standard form. The statement generation workstation

generates an electronic statement based on the template and statement data. See

columns 9-10. The statement generation workstation receives templates and statement

data for the template. The statement can include static information and dynamic

information. The static information is stored in the template, while the dynamic

information is transmitted separately and combined later to generate a complete

statement. See column 6, lines 14-25 and column 11, lines 1-18. Compare to *"a*

dynamic web-based design editor running on said client computer, said web-

based design editor allowing a user to initially define and continually redefine

attributes of the desired product using said editor." Kolling further teaches that a

variety of data formats for transmitting an electronic statement can be used such as

Adobe PDF format. See column 6, lines 4-10 and column 10, lines 10-34. Specifically,

when the statement generation workstation receives a template when a statement data

for a new template or version of the template. A template may be transmitted when a

new template is created or when there are changes to the template. Since a template

may be created to contain only static data (unlike dynamic statement data that is

different), templates may only need to be transmitted from the template authoring

workstation. A new template or different version can be generated when there is new

data (dynamic data). See column 11, lines 1-20. The template and statements can be

used to generate a statement in PDF format over the Internet. The electronic statement

generated may be represented in a one file or in numerous files in any data format

desired., such as multiple PDFs. See column 29, lines 47-60. Compare to *"a PDF*

rendering engine in communication with said web-based design editor for

automatically generating a PDF based on said initially defined attributes of the desired product and for automatically generating additional PDFs based on said continually redefined attributes at the client computer, wherein said server, said computer, and said engine are in communication with each other".

In reference to claim 2, Kolling teaches having a central database with biller information made available to the system. See column 14, lines 5-31.

In reference to claim 4, Kolling teaches producing the electronic statement based on the PDF. See column 10.

In reference to claim 6, Kolling teaches that the template can include logos, special fonts, and any graphics to be presented on the statement. See column 9, lines 50-67.

In reference to claim 13, Kolling teaches providing a graphical representation of the electronic statement (product) with its related elements. See figure 6B, element 538. Kolling further teaches that creating the design editor involves defining tables and relations sufficient to represent the most general case of the statement and graphically laying out the data elements to be placed on the statement. See figure 6B and column 17, lines 40-56.

In reference to claim 17, Kolling teaches that the user may edit elements in the statement using the template. See figure 6B.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

6.   Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et

al., US 6,385,595 B1, 5/7/02 (filed 6/25/99) in view of Hitchcock et al., US 6,345,278 B1,

2/5/02 (filed 6/3/99).

In reference to claim 3, Kolling does not state the use of name-value pairs;

however, Hitchcock does. Hitchcock teaches customizing an application using name-

value pairs. Hitchcock's system allows for new applicant attributes to be incorporated

into the system and allows the content and appearance of the application to be

changed. It would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate the entry of name-value pairs into the rendering engine of

Kolling as it allows for a value to be associated with a name and furthermore, Hitchcock

and Kolling are of analogous art in that they deal with customizing a product using an

editing program. See abstract of Kolling and column 8, lines 20-38 of Hitchcock.

7.   Claims 7-10, 12, 18, and 20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hitchcock et al., US 6,345,278 B1, 2/5/02 (filed 6/3/99) in view of

Kolling et al., US 6,385,595 B1, 5/7/02 (filed 6/25/99).

In reference to claim 7, Hitchcock teaches a system for customizing an

application over the Internet. The content and appearance of the application can be

changed. Hitchcock's system uses customizable on-line forms. The forms are branded

for its institution and differ in appearance and content. The user can include new

attributes to the original attributes. See abstract. Compare to *"designing a product,*

comprising the steps of: providing to a user at least one web page including selectable preliminary choices about the product; receiving an indicator of said preliminary design choices from the user;" Hitchcock teaches customizing an application using name-value pairs. Hitchcock's system allows for new applicant attributes to be incorporated into the system and allows the content and appearance of the application to be changed. Compare to *"receiving name-value pairs of information describing at least one attribute of said product"*. Hitchcock further discloses receiving entering a second set of name-value pairs into a form. More fields are submitted and changes in format are made. See column 15. Compare to *"receiving a second set. . .at least on attribute of said product"*. While Hitchcock's customization of an application is done using web based forms, it does not necessarily disclose a design editor. Kolling does. As discussed above in reference to claim 1, Kolling teaches an electronic statement presentment system in which statements are built using a template authoring workstation and transmitted over a server to a customer. See abstract and column 10, lines 25-38. The authoring (or design) system comprises a computer located at the biller (client) who utilizes current authoring packages to create templates for creating an electronic statement (product). See column 9, lines 50-67. Kolling further teaches that a variety of data formats for transmitting an electronic statement can be used such as Adobe PDF format. See column 6, lines 4-10 and column 10, lines 10-34. Specifically, when the statement generation workstation receives a template when a statement data for a new template or version of the template. A template may be transmitted when a new template is

created or when there are changes to the template. Since a template may be created to

contain only static data (unlike dynamic statement data that is different), templates may

only need to be transmitted from the template authoring workstation. A new template or

different version can be generated when there is new data (dynamic data). See column

11, lines 1-20. The template and statements can be used to generate a statement in

PDF format over the Internet. The electronic statement generated may be represented

in a one file or in numerous files in any data format desired., such as multiple PDFs.

See column 29, lines 47-60It would have been obvious to one of ordinary skill in the art

at the time of the invention to combine Kolling's design system in a web page as taught

by Hitchcock as it allows a user to access the design system via the Internet and

extends its accessibility. Furthermore, it would have been obvious to one of ordinary

skill in the art at the time of the invention to incorporate the entry of name-value pairs

into the rendering engine of Kolling as it allows for a value to be associated with a name

and furthermore, Hitchcock and Kolling are of analogous art in that they deal with

customizing a product using an editing program. See abstract of Kolling and column 8,

lines 20-38 of Hitchcock. Compare to *"providing a web-based design editor to said*

user" and *"generating a PDF based on said preliminary design choices and said*

name-value pairs" and *"generating a second PDF based on said second set of*

name-value pairs".

In reference to claim 8, both Hitchcock and Kolling teach publishing the PDF

document once it has been customized to the user's liking. See column 8, lines 20-40

of Hitchcock and column 6 and 10 of Kolling.

In reference to claims 9 and 10, both Hitchcock and Kolling teach providing a template or online-form from a database. See figure 1 of Hitchcock and figure 5 and 17 of Kolling. It was well known in the art at the time of the invention to provide software products from both local memory caches and remote servers to a user, thus it would have been obvious to one of ordinary skill in the art at the time of the invention to obtain the editor from a memory cache or a web server.

In reference to claim 12, Hitchcock teaches customizing an application using name-value pairs. Hitchcock's system allows for new applicant attributes to be incorporated into the system and allows the content and appearance of the application to be changed. See column 8, lines 20-38.

Claim 18 is rejected under the same rationale used in claim 7 above.

In reference to claim 20, although Hitchcock and Kolling do not teach the electronic display to be an Internet website portal, it would have been obvious to one of ordinary skill in the art to utilize the design engine and web-based design tool to develop a series of webpages to make up an Internet website portal as the tools simply allow a user to define certain features of a document.

8.   Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al., US 6,385,595 B1, 5/7/02 (filed 6/25/99).

In reference to claim 14, Kolling does not state that the table and the graphical layout are displayed in two separate screen windows; however, as Kolling does suggest that the elements are represented by the table. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to display these two elements in

different screens to allow the user to visualize the table and graphical representation separately.

In reference to claim 15, Kolling discloses a computer system and a means for using a cursor for selection on an electronic presentment system; however, he does not specifically mention using a mouse to make a selection. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use a mouse in making a selection in Kolling's system because it was well known to use one of several suitable means for inputting and selecting data, including the use of a mouse.

9.   Claims 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitchcock et al., US 6,345,278 B1, 2/5/02 (filed 6/3/99) in view of Kolling et al., US 6,385,595 B1, 5/7/02 (filed 6/25/99), as applied to claim 7 and 18 above, and in further view of Ferguson et al., US 5,819,092, 10/6/98.

In reference to claims 11 and 19, Hitchcock/Kolling do not teach a drag-and-drop functionality; however, Ferguson does. Ferguson teaches an online development tool in which drag-and-drop functionalities can be used on the user interface. See column 19, lines 5-25. It would have been obvious to one of ordinary skill in the art to utilize a drag-and-drop functionality to relocate attributes in the system of Kolling since it is an efficient way to move objects around on a graphical interface.

10.   Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al., US 6,385,595 B1, 5/7/02 (filed 6/25/99) in view of Ferguson et al., US 5,819,092, 10/6/98.

In reference to claim 16, Kolling do not teach a drag-and-drop functionality; however, Ferguson does. Ferguson teaches an online development tool in which drag-and-drop functionalities can be used on the user interface. See column 19, lines 5-25. It would have been obvious to one of ordinary skill in the art to utilize a drag-and-drop functionality to relocate attributes in the system of Kolling since it is an efficient way to move objects around on a graphical interface.

Response to Arguments

11.   Applicant's amendments to the claims have been addressed above. Applicant argues that Kolling describes creating a .PDF template but not customizing the template in any way. Examiner respectively disagrees. Kolling teaches an electronic statement presentment system in which a template (compare to editor) is created at a template authoiring workstation. The template identifier along with statement data are then sent to a statement origination workstation. A template along with the statement data is then combined and delivered to a customer in any format, including PDF format. Kolling teaches an electronic statement presentment system in which statements are built using a template authoring workstation and transmitted over a server to a customer. See abstract and column 10, lines 25-38. The authoring (or design) system comprises a computer located at the biller (client) who utilizes current authoring packages to create templates for creating an electronic statement (product). See column 9, lines 50-67. When a template is sent to the statement origination workstation, it validates statement data with template. The validation includes transmitting statement data in standard form. The statement generation workstation generates an electronic statement based

on the template and statement data. See columns 9-10. The statement generation

workstation receives templates and statement data for the template. The statement can

include static information and dynamic information. The static information is stored in

the template, while the dynamic information is transmitted separately and combined

later to generate a complete statement. See column 6, lines 14-25 and column 11, lines

1-18. Kolling further teaches that a variety of data formats for transmitting an electronic

statement can be used such as Adobe PDF format. See column 6, lines 4-10 and

column 10, lines 10-34. Specifically, when the statement generation workstation

receives a template when a statement data for a new template or version of the

template. A template may be transmitted when a new template is created or when there

are changes to the template. Since a template may be created to contain only static

data (unlike dynamic statement data that is different), templates may only need to be

transmitted from the template authoring workstation. A new template or different

version can be generated when there is new data (dynamic data). See column 11, lines

1-20. The template and statements can be used to generate a statement in PDF format

over the Internet. The electronic statement generated may be represented in a one file

or in numerous files in any data format desired., such as multiple PDFs. See column

29, lines 47-60. Thus the concept of a "dynamic web-based design editor" is disclosed

by Kolling's dynamic template generation. See also column 10, lines 10-20, *"A variety*

of authoring tools may be used on TAWS 210. By way of example, the tools

Microsoft Access version 8 and Adobe Acrobat version 3.0 have been found to

have desirable results. Production of enclosures may use any desktop publishing

software capable of producing output in Adobe Postscript or PDF format, for

example, or in any other format supported by the system. Since PDF enclosures

can incorporate links that point to Internet addresses, any web authoring tools

can also be used to produce documents accessible from statement enclosures."

Applicant argues that Hitchcock does not teach customization via real-time web

page submission. Examiner maintains that Applicant's claim does not recite such

features, but simply recites limitations for generating a PDF based on name-value pairs.

In view of the rejections and comments above, Examiner has maintained the rejection.

Conclusion

12.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Rachna Singh whose telephone number is 571-272-

4099. The examiner can normally be reached on M-F (8:30AM-6:00PM). If attempts to

reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph

Feild can be reached on 571-272-4090. The fax phone number for the organization

where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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Business Center (EBC) at 866-217-9197 (toll-free).

RS
2/20/04

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER